

REMARKS

The present Amendment and Response is filed in response to the Final Office Action dated July 9, 2004 ("Office Action"). Claims 34-36, 38-42, 46-48, 50-63 have been amended, no claims have been added, and no claims have been cancelled by this amendment. Accordingly, Claims 34-63 remain pending. In view of these amendments, as well as for the reasons as discussed below, the Applicants respectfully assert that the previous rejections are now moot, and that the pending claims are in condition for allowance.

By this Amendment and Response and the accompanying Request for Continued Examination ("RCE") the Applicants' pending appeal in this case is hereby withdrawn from the Board of Patent Appeals and Interferences.

Claim Rejection Under 35 U.S.C. § 101

In the Office Action, the Examiner rejected Claims 34-45 and 56-63 under 35 U.S.C. § 101, alleging that the claimed invention was purportedly directed to non-statutory subject matter. In particular, the Examiner cites *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978) and *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BPAI 2001) for the proposition that 35 U.S.C. § 101 includes a "technological arts" test. Claims 34-45 and 56-63 allegedly do not satisfy this purported "technological arts" test. The Applicants respectfully submit that, in view of *Ex parte Lundgren* and the USPTO's new Guidelines for Subject Matter Eligibility, the Examiner's rejections of Claims 34-45 and 56-63 under the purported "technological arts" test of 35 U.S.C. § 101 are now moot.

In particular, the Board of Patent Appeals and Interferences in *Ex parte Lundgren*, Appeal No. 2003-2088, Application 08/093,516 (Precedential BPAI opinion September 2005),

expressly rejected the existence of this separate “technological arts” test relied upon by the Office Action. Indeed, after reviewing *In re Musgrave*, 431 F.2d 882, 167 USPQ 280 (CCPA 1970), *In re Toma*, and *Ex parte Bowman*, the Board of Patent Appeals and Interferences expressly stated in *Ex parte Lundgren*:

Our determination is that there is currently no judicially recognized separate “technological arts” test to determine patent eligible subject matter under § 101. We decline to propose to create one. Therefore, it is apparent that the examiner’s rejection can not be sustained. (*see* page 9)

As a result of *Ex parte Lundgren*, the USPTO issued new Guidelines for Subject Matter Eligibility on (*see* OG Notice of November 22, 2005, available at <http://www.uspto.gov/web/offices/com/sol/og/2005/week47/patgupa.htm>) (“*Guidelines*”). Indeed, the new *Guidelines* indicate that:

USPTO personnel should no longer rely on the technological arts test to determine whether a claimed invention is directed to statutory subject matter. There is no other recognized exceptions to eligible subject matter other than laws of nature, natural phenomena, and abstract ideas.

(OG Notice of November 22, 2005).

Accordingly, the Applicants respectfully submit that, in view of *Ex parte Lundgren* and the new *Guidelines*, the Office Action’s rejections of Claims 34-45 and 56-63 under 35 U.S.C. § 101 are now moot. Furthermore, the Applicants respectfully state that Claims 34-45 and 56-63 “produce a useful, concrete, tangible result,” (*see AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 1358, 50 USPQ2d 1447, 1452 (Fed. Cir. 1999)), and are not directed towards “laws of nature, physical phenomena, [or] abstract ideas,” (*see Diamond v. Diehr*, 45 U.S. 175, 185, 209 USPQ 1, 7 (1981)), and are thus directed towards statutory subject matter under 35 U.S.C. § 101.

Independent Claim Rejections Under 35 U.S.C. § 102

In the Office Action, the Examiner rejected Claims 34, 38, 41-43, 46, 50-51, 53-54 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,699,528 to Hogan ("*Hogan*").

As an initial matter, the Applicants have amended Claims 34-36, 38-42, 46-48, 50-63 to further clarify the claimed invention as recited therein. For example, the Applicants have amended independent Claim 34 to include, among others, the step of "transmitting a presentation comprising (i), in a first portion of a single screen, a the bill including at least one of a total amount due and or a minimum amount due, and a payment due date; and (ii), in a second portion of the single screen, bill payment information including a payment date area displaying a pre-populated payment date derived from the payment due date of the bill, and a payment amount area displaying a pre-populated payment amount derived from at least one of the total amount due or the minimum amount due of the bill." (Emphasis added). Independent Claims 46 and 56, system analogues of Claim 34, have been similarly amended. As further described below, the Applicants respectfully assert that *Hogan* fails to teach or suggest the steps as amended. More specifically, the Applicants assert that *Hogan* does not teach or suggest "displaying a pre-populated payment date derived from the payment due date of the bill," or "displaying a pre-populated payment amount derived from at least one of the total amount due or the minimum amount due of the bill."

In the previous Office Action, the Examiner rejected independent Claim 34 as being anticipated by FIG. 4 of *Hogan*, and alternatively states that where a "payment due date," as recited in Claim 34, cannot be found in FIG. 4, FIG. 11 of *Hogan* shows the same. (See Office Action, pp. 5-6, 13). FIG. 4 of *Hogan* illustrates a web embodiment of an electronically presented bill. The presented information includes a total amount due and information

associated with a payment. However, FIG. 4 and the associated text at col. 6, lines 25-64, clearly does not teach or suggest “a pre-populated payment date,” “a pre-populated payment amount,” “a payment due date,” or “a minimum amount due,” as recited in amended independent Claim 34.

The Applicants respectfully assert that FIG. 4 does not teach or suggest “a pre-populated payment date derived from the payment due date of the bill.” Furthermore, the Applicants submit that *Hogan* actually teaches away from pre-populating the payment date with a date derived from the due date of the bill. The pay date 407 element of *Hogan* clearly does not show a payment date in the same, single screen as the other elements. At best, *Hogan* allows the user to select the “today” option in the pay date 407 element to cause the server to process the payment on the current date. (*Hogan*, col. 6, lines 37-41). However, in this embodiment of *Hogan*, a payment date is not even displayed; instead, the word “today” selected by default is displayed in FIG. 4. (*See Hogan*, FIG. 4, 407 element). Thus, because *Hogan* teaches defaulting the payment date to the current date, *Hogan* teaches away from pre-populating the payment date to a date other than the current date, such as a date derived from the payment due date, as is recited in Claim 34. Accordingly, the Applicants submit that because *Hogan* teaches away from pre-populating the payment date with a date derived from the payment due date of the bill, this feature of Claim 34 is necessarily novel and non-obvious over *Hogan*.

Notwithstanding that *Hogan* teaches away from pre-populating the payment date, the Applicants additionally assert that *Hogan* further fails to teach or suggest the presenting a payment date in the same, single screen as the other elements recited in Claim 34. More specifically, in *Hogan* a date is only displayed if the “another date” option is selected, after which the server “prompts the subscriber to enter a future date as the payment date.” (*Hogan*,

col. 6, lines 41-43). Accordingly, although a payment date may be displayed in a second presentation in *Hogan* – the future date entered by the user, (*see Hogan*, col. 6, lines 41-43), a payment date is not displayed in the *single* web screen illustrated by FIG. 4, and therefore *Hogan* does not teach “transmitting a presentation comprising . . . in a second portion of the single screen, bill payment information including a payment date area displaying a pre-populated payment date,” as recited by Claim 34. Furthermore, to the extent the Examiner argues that the “prompt,” as described at col. 6, lines 41-43 of *Hogan*, causes the payment date to be displayed in the single screen, the Applicants respectfully state that *Hogan* does not enable such an embodiment, and therefore *Hogan* can not be used as a reference teaching such a feature. (*See* MPEP § 2121.01 (stating that “[t]he disclosure of a reference must provide an enabling disclosure of the desired subject matter; mere naming or description of the subject matter is insufficient . . .”)).

Additionally, the Applicants respectfully state that any payment date that may be displayed by *Hogan* in FIG. 4 is not “derived from the payment due date of the bill,” as is recited in Claim 34. In contrast to Claim 34, FIG. 4 requires the “user to enter a future date as the payment date.” (*Hogan*, col. 6, line 44). Thus, because any embodiment described in *Hogan* that may display a date different from the default date of either the due date or the current date requires the user to select the date (as described above), *Hogan* fails to teach or suggest “displaying a pre-populated payment date derived from the payment due date of the bill.”

Similarly, the Applicants respectfully disagree with the Examiner that FIG. 4 teaches “a pre-populated payment amount . . .” The amount 410 element of *Hogan* clearly does not show a pre-populated payment amount in the same, single screen as the other elements recited in Claim 34. More specifically, if the “full” option is selected, then “the server computer retrieves

from its memory the full bill amount,” (*Hogan*, col. 6, lines 55-59), but does not display a payment amount at all, let alone a pre-populated payment amount. Furthermore, if the “allowed partial” option is selected, the server “prompts for the allowed partial payment amount.” (*Hogan*, col. 6, lines 60-64). Accordingly, for similar reasons as are discussed above in relation to the “payment date,” the prompt by the server in *Hogan*, (*see Hogan*, col. 6, lines 60-64), does not display a pre-populated payment amount in the single screen illustrated by FIG. 4. Therefore, *Hogan* does not teach or suggest “transmitting a presentation comprising . . . in a second portion of the single screen, . . . a payment amount area displaying a pre-populated payment amount,” as recited by Claim 34. Also similar to that discussed above, *Hogan* does not teach or suggest displaying “a pre-populated payment amount derived from at least one of the total amount due or the minimum amount due of the bill,” because *Hogan* “prompts [the user] for the allowed partial payment amount” – the only indication of a payment amount being displayed. (*Hogan*, col. 6, lines 63-64).

With respect to FIG. 11 of *Hogan*, the Applicants respectfully submit that FIG. 11 fails to teach or suggest at least displaying in a second portion of a single screen “a pre-populated payment date” and “a pre-populated payment amount,” as recited in independent Claim 34. More specifically, FIG. 11 illustrates an email service embodiment of an electronically presented bill. (*See Hogan*, col. 9, lines 1-5). Although the subject field 1105 contains the payee’s name, bill amount, and due date, FIG. 11 fails to teach or suggest any “payment date” or “payment amount” displayed in a second portion of the same, single screen, as recited by Claim 34. Accordingly, because the FIG. 11 fails to disclose, teach, or suggest displaying each element required by Claim 34 in a single screen, FIG. 11 does not anticipate Claim 34.

In addition, the Applicants submit that the advantages gained by presenting the elements recited in Claim 34 together, in a single screen, in an orderly manner, and by pre-populating them without requiring input by the user or additional steps to cause information to be presented, are not provided by *Hogan* in any of its embodiments or any combinations thereof. As discussed above, *Hogan* does not teach or suggest each of the elements recited in Claim 34 and, thus, the positions taken by the Examiner still fail to produce the benefits achieved by the invention as recited in Claim 34.

Accordingly, neither FIG. 4 nor FIG. 11 teach or suggest “displaying a pre-populated payment date derived from the payment due date of the bill” and “displaying a pre-populated payment amount derived from at least one of the total amount due or the minimum amount due of the bill,” as recited in amended Claim 34. The Applicants respectfully state that, for at least these reasons, *Hogan* does not anticipate independent Claim 34 under 35 U.S.C. § 102 for failing to teach each limitation. Furthermore, the Applicants assert that dependent Claims 35-45 are allowable as a matter of law as depending from an allowable claim, notwithstanding their independent recitation of patentable features.

The Applicants have additionally amended independent Claims 46 and 56 to recite similar features as discussed above regarding independent Claim 34. *Hogan*, therefore, does not anticipate or render obvious Claims 46 and 56 for similar reasons as those stated with regards to independent Claim 34. Furthermore, the Applicants state that dependent Claims 47-55 and 57-63 are allowable as a matter of law as depending from an allowable claim, notwithstanding their independent recitation of patentable features.

Dependent Claim Rejections Under 35 U.S.C. § 102

In the Office Action, the Examiner rejected dependent Claims 38, 41-43, 50-51, 53-54 under 35 U.S.C. § 102(b) as being anticipated by *Hogan*. Notwithstanding that each of the rejected dependent claims are allowable as a matter of law as depending from an allowable claim, as discussed above, the Applicants provide the following additional remarks related to select dependent claims.

The Examiner rejected dependent Claims 38, 50, and 57, relying on the “amount” 411 element in FIG. 4 of *Hogan* as teaching “a periodic payment area for displaying a periodicity at which further payments of the displayed payment amount are to be made after the displayed payment date.” The Applicants respectfully submit that no part of FIG. 4 teaches or suggests displaying a periodicity at which payments are to be made. Instead, *Hogan* describes that the “amount” element 411 allows the server to prompt the user for the allowed partial payment *amount*, not for the *periodicity* of the payments. (*Hogan*, col. 6, lines 60-64). Accordingly, the Applicants respectfully state that dependent Claims 38, 50, and 57 are not anticipated or rendered obvious by *Hogan* for at least this additional reason.

The Examiner rejected dependent Claims 43, 54, and 61, relying on FIG. 10 and FIG. 11 of *Hogan* as teaching “displaying, on the single screen, a selectable biller list including a plurality of billers.” First, the Applicants state that FIG. 10 describes a list of unpaid and/or unviewed e-mail billing items that is presented to a user via a first display screen. A list of unpaid and/or unviewed e-mail billing items is different from a selectable *biller list*. Then, FIG. 11 (described above) is invoked in response to the user’s selection of one of the billing items of FIG. 10. Accordingly, the Applicants respectfully submit that *Hogan* fails to teach the features of Claims 43, 54, and 61 in a single screen. Furthermore, where the Examiner has argued that

"*Hogan* teaches a selectable biller list (Electric Co.) a list can consist of one item," referring to FIG. 11, (*see* Advisory Action), the Applicants respectfully assert that Claims 43 and 61 each recite "a selectable biller list including a *plurality of billers*," and Claim 54 recites "a *plurality of biller identifiers* on the single screen," and therefore the Examiner's argument that a list of one item fails to anticipate the "plurality" of billers or biller identifiers recited by dependent Claims 43, 54, and 61 for at least this additional reason.

The Examiner rejected dependent Claims 41 and 53, relying on FIG. 4 of *Hogan*, as teaching "receiving a user command to change the displayed payment date to a modified payment date; and automatically changing the displayed payment date to the modified payment date" The Applicants respectfully state that FIG. 4 does not display a payment date at all, but merely displays an indication to direct a payment on the date a bill is being viewed, and subsequently displaying an entirely different screen for entering a particular payment date other than the instant day that a bill is being viewed by the user, as discussed in more detail above in regards to Claim 34. (*See Hogan*, col. 6, lines 37-45). Accordingly, the Applicants respectfully state that *Hogan* fails to anticipate dependent Claims 41 and 53 for at least these additional reasons.

Claim Rejections Under 35 U.S.C. § 103

In the Office Action, the Examiner rejected independent Claim 56 and dependent Claims 35-37, 39-40, 44-45, 47-49, 52 and 55, 57-63 under 35 U.S.C. § 103 as being obvious in view of *Hogan*. The Applicants have amended independent Claim 56, making the Examiner's rejection thereof moot in light of the present amendments and the remarks provided above. Notwithstanding that each of the rejected dependent claims are allowable as a matter of law as

depending from an allowable claim, as discussed above, the Applicants provide the following additional remarks related to select dependent claims.

As an initial matter, the Applicants have amended independent Claim 56 in a manner similar to that described with regards to independent Claim 34, including the features of “displaying a pre-populated payment date derived from the payment due date of the bill” and “displaying a pre-populated payment amount derived from at least one of the total amount due or the minimum amount due of the bill” Thus, the Applicants respectfully state that for at least the same reasons as discussed above with respect to independent Claim 34, *Hogan* fails to teach, suggest, or render obvious each of the elements recited in independent Claim 56.

Second, in the Office Action the Examiner rejected Claims 35-37, 47, 48, and 56, though expressly admitted that “Hogan does not specifically teach that the payment date corresponds to a time period for making payment in a particular manner.” (*See* Office Action, p. 9). Instead, the Examiner took Official Notice “that it is old and well known in bill paying for billers to specify a time period where they no longer will receive checks but where the only payments accepted will be money order or cash in order to avoid prolonging the time period of payment.” (*See* Office Action, p. 9). As in each reply since this Official Notice was first taken by the Examiner, the Applicants respectfully assert that the Official Notice is improper, as the Examiner’s Notice is overreaching and extends beyond the situations in which it is permissible for Official Notice to be taken.

First, because the Examiner has not provided documentary evidence showing that such facts are well-known each time the Applicants have requested such evidence, (*see* Response filed April 12, 2004, Response filed September 9, 2004; *see also* Appeal Brief filed December 13, 2004, Reply Brief filed May 11, 2005), the Applicants submit that the Examiner has failed to

illustrate to the Applicants to the propriety of the Official Notice. Not responding to the Applicants' request suggests to the Applicants that the Examiner's Official Notice is incapable of instant and unquestionable demonstration as being well-known, as is required for proper Official Notice. (See MPEP 2144.03 (citing *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA))).

Second, the Applicants state that Official Notice "should be judiciously applied" and reserved for facts "of notorious character." (See MPEP 2144.03 (E)). Additionally, Official Notice should only very rarely be relied on when an application is under final rejection, and "[i]t is never appropriate to rely solely on 'common knowledge' in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based." (See MPEP 244.03 (A) (citing *In re Zurko*, 258 F.3d 1379, 1385, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001)). The Applicants respectfully submit that the Examiner has violated each of these principals: (1) by maintaining the Official Notice through the Final Office Action without submitting documentary evidence when requested, and (2) by extending it beyond facts of notorious character.

Accordingly, the Applicants respectfully submit that the Examiner's rejection of dependent Claims 35-37, 47, and 48 is improper and respectfully request evidence to support the Examiner's Official Notice taken, or withdraw the Official Notice.

With respect to Claims 40, 45, 52, 55, 59, and 63, the Examiner alleged in the Office Action that it would have been obvious to modify *Hogan* to arrive at "the displayed bill payment information [] displayed in a format of a check," without properly citing to any prior art references. The Examiner stated that it would make sense if paying with a check to change the display because such a modification would allow the customer to interact with a display that he or she is familiar with. (See, e.g., Office Action, page 11). The Applicants respectfully submit

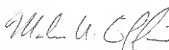
that it would not have been obvious to so modify *Hogan* without having the benefit of the Applicants' application. Accordingly, the Applicants respectfully submit that the rejection is improper, and that Claims 40, 45, 52, 55, 59, and 63 are non-obvious, and allowable under 35 U.S.C. § 103.

In summary, the Applicants respectfully submit that each of the currently pending claims are allowable for at least the reasons discussed above. However, if there are any issues that can be resolved by a telephone conference or an Examiner's amendment, the Examiner is invited to call the undersigned attorney.

CONCLUSION

Reconsideration of the present Application is requested in light of the amended claims and the remarks. The Applicants believe they have responded to each matter raised by the Examiner in the Final Office Action. Allowance of the claims is respectfully solicited. It is not believed that any extensions of time or additional fees are required beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. §1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 19-5029.

Respectfully submitted,



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